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**AUG 23 2006**

**Technology Center 2100**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/681,573  
Filing Date: May 01, 2001  
Appellant(s): ZETTEL ET AL.

Kent L. Baker, Reg. No. 52,584  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 16 June 2006 appealing from the Office action mailed 17 October 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Academic Technology Services, "Adobe PDF for Electronic Publishing," 1999

6336124	Alam et al.	1-2002
6370567	Ouchi	4-2002
6009442	Chen et al.	12-1999

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13-15, 25, 27, and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Academic Technology Services (hereafter ATS) (Adobe PDF for Electronic Publishing, 1999) and further in view of Bendik (US 2002/0002563, filed 23 August 1999, published 3 January 2002).

As per independent claim 1, ATS discloses a method to electronically publish media comprising the steps of:

- Accessing an electronic data file (page 3, number 1)
- Receiving a publication instruction from a document creation application to publish the accessed data file (page 3, number 2)

- Initializing a publication enabler capable of converting a data file into at least one publication format, wherein the publication enabler is independent of a document creation application used to create the electronic file (pages 4-5, numbers 3-6)
- Selecting a publication format via the publication enabler (pages 23-24)
- If necessary, converting the accessed data file directly into another publication format (pages 4-5, numbers 3-6)
- Publishing the data file in at least one publication format (page 5, number 7)

ATS fails to specifically disclose a document management system. However, Bendik discloses a document management system with storage criteria (paragraphs 0007-0013).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 2, ATS and Bendik discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein the step of publishing further comprises storing the data file in memory of a computer (page 5, number 7: Here, the PDF can be immediately displayed and stored).

As per dependent claim 3, ATS and Bendik disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Bendik further discloses

the method further comprising the step of routing a publication notification to at least one of an approving supervisor and a work flow recipient from the publication enabler (paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's method with Bendik's method, since it would have allowed for easy collaboration between workgroups.

As per dependent claim 4, ATS and Bendik discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein at least one of the publication format includes at least one of an RTF, HTML, PDF, TIFF, JPEG, GIF, BMP, and fax compression format (page 5, number 7).

As per dependent claim 5 ATS and Bendik discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein the step of publishing further comprises the step of transmitting the data file to a system wherein the data file are configured to allow the system to automatically assign a coded filename, a storage location, and a file identifier to the data file (page 5, number 7: Here, the file is saved to the hard drive in a document management system under a filename). Bendik further discloses the method wherein a document management system receives a plurality of parameters used to automatically assign a file a coded filename, a storage location, and a file identifier (paragraph 0049: Here, a naming system is created when the document management system is

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implemented. This naming system specifies the coded file name, storage location, and file identifier that all documents will receive, based upon the document's parameters).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 6 ATS and Bendik discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. ATS discloses the method further comprising the step of retrieving the data file based on any of the file identifier, coded filename, storage location, and document parameters wherein the document parameters include at least one of an author, a title, a subject, a format, an approver, and a work flow recipient (page 13, Viewing a PDF file: Here, the data file is retrieved through the filename based upon a user selection).

As per dependent claim 7 ATS and Bendik disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein the publication instruction is a print command and further comprising the steps of initializing the publication enabler with an application capable of printing the electronic data file (page 3, Creating a PDF from an existing electronic document: Here, the PDF is published from a word processing document, through a print command).

As per independent claim 8, the applicant discloses the computer readable storage device having stored thereon a program for executing the method of claim 1. Claim 8 is similarly rejected under ATS and Bendik.

As per dependent claim 9 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS further discloses the computer readable storage device wherein the at least one publication format includes media formats foreign to the media creation application (page 3, Creating a PDF from an existing electronic document: Here, the original document is foreign to the final PDF application).

As per dependent claim 10 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS further discloses the computer readable storage device wherein the at least one publication format includes at least one of a portable document format, a hypertext markup language, an x-markup language, a rich text format, a JPEG format, a GIF format, a TIFF format, encryption formats, a bitmap format, compression format, or electronic messaging formats (page 5, number 7).

As per dependent claim 11, the applicant discloses the computer readable storage device for executing the method of claim 5. Claim 11 is similarly rejected under ATS and Bendik.

As per dependent claim 13 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS further discloses the computer readable storage device wherein the computer is further caused to



initialize the media publisher in response to a print command from a plurality of media creation applications (page 3, Important Note: Here, the publishing can be implemented with files stored on either a Window or Macintosh machine, each machine containing different proprietary applications).

As per dependent claim 14, the applicant discloses the computer readable storage device for executing the method of claim 6. Claim 14 is similarly rejected under ATS and Bendik.

As per dependent claim 15 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS and Bendik further discloses the computer readable storage device wherein the computer is further caused to electronically transmit the content to a remote terminal to at least one of a supervising approver and a workflow recipient (ATS: page 14: Distributing and Viewing PDF files on the Web: Here, the web is a communication interface; Bendik: paragraph 0058-0059: Here, the document or a link to the document is mailed to another person for review and modification).

As per independent claim 25, ATS discloses a system for publishing document to a document management system comprising:

- A computerized network (page 14: Distributing and Viewing PDF files on the Web: Here, the web is a computerized network)
- A readable memory electronically linked to a network (page 14: Distributing and Viewing PDF files on the Web: Here, the server is a memory electronically linked to a network)

- A plurality of computer connected to the network, wherein at least one of the plurality of computers, displays electronic data to a user in the form of a GUI (page 14: Distributing and Viewing PDF files on the Web; page 3)
- A processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats, wherein the one or more publication formats including publications formats non-native to a creation document (pages 4-5, numbers 3-6)
- The processing unit is further programmed to convert a document to at least one of the publication formats and call the GUI directly from the application used to create a document a user desires to publish (page 5, number 7)

ATS fails to specifically disclose conforming to a document management system with parameters. However, Bendik discloses conforming data to a document management system with parameters (paragraph 0049).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 27 ATS and Bendik disclose the limitations similar to those in claim 25, and the same rejection is incorporated herein. Bendik further discloses the system wherein the processing unit is further programmed to automatically assign document management system publication parameters, wherein

the document management system parameters include at least one of a document category, document format, document approval, and document workflow (paragraph 0049).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 29, ATS and Bendik disclose the limitations similar to those in claim 25, and the same rejection is incorporated herein. Bendik further discloses the system wherein the processing unit is further programmed to route the document to at least one supervising approver and work flow document recipient upon a user instruction (paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's method with Bendik's method, since it would have allowed for easy collaboration between workgroups.

Claims 12 remains rejected and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Bendik (US 2002/0002563, filed 23 August 1999, published 3 January 2002) and further in view of Alam et al. (US 6336124, filed 7 July 1999, patent 1 January 2002, hereafter Alam).

As per dependent claim 12, ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS and Bendik fail to specifically disclose the computer readable storage device wherein the computer further caused the computer to receive more than one media control instruction and simultaneously transform the content of the electronic media into more than one format. Alam discloses the computer program wherein the set of instructions further causes the computer to receive more than one media control instruction and simultaneously transform the content of the electronic media into more than one format (Figure 6, items 626 and 534: Here, a PDF and an Output Format Document are both generated based upon one command).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's program for publication with Alam's program for generating multiple document formats, since it would have allowed a user to generate multiple documents for several applications.

As per independent claim 16, ATS discloses the computer readable storage medium having a computer program stored thereon and embodying a sequence of instructions that when executed by a processor causes the processor to:

- (A) access an electronic file (page 3, number 1)
- (B) display a GUI configured to facilitate a user selection of a number of publications commands (pages 4-5, numbers 1-6)
- (C) receive a user selection of at least one publication command (page 3, number 2)

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- (D) converting data directly from one format into a publication format (page 3, number 1- page 5, number 7)
- (E) transmit the converted data to at least one publication system capable of publishing the data file into a publication format (page 5, number 7)

ATS fails to specifically disclose:

- A document management system
- (D) route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats
- (E) two converted data files

Bendik discloses a document management system (paragraphs 0007-0013).

Alam discloses:

- (D) route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats (Figure 6: Here, a PDF and an Output Format Document are publication formats.)
- (E) two converted data files (Figure 6)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's medium with Bendik's medium, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002). Further, it would have been obvious to one of ordinary skill

in the art at the time of the applicant's invention to have combined ATS and Bendik's medium with Alam's medium for using multiple data files, since it would have allowed a user to save time by creating more than one file with a single publication command.

As per dependent claim 17 ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to display the GUI in response to a document management instruction (page 3, Figure 1).

As per dependent claim 18 ATS, Bendik, and Alam disclose the limitations similar to those in claim 17, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to execute acts (A) through (E) in response to a user print instruction (Figure 1).

As per dependent claim 19 ATS, Bendik, and Alam disclose the limitations similar to those in claim 18, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to recognize a user print instruction from any software application capable of printing the electronic data file (page 3, Creating a PDF from an existing electronic document).

As per dependent claim 20 ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam further discloses the print driver wherein the number of publication commands include a publish

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command including a convert to a PDF command and a convert to HTML command (column 2, lines 28-36).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS, Bendik, and Alam's medium for publication with Alam's method of converting to PDF and HTML, since it would have allowed a user to convert data into more than out format.

As per dependent claim 21, ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the number of publication formats include PDF, JPEG, GIF, TIFF, HTML, XML, RTF, TXT, DOC, encryption, PPT, and ZIP (page 5, number 7).

As per dependent claim 22, ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to retrieve an electronic data file from a document management system capable of storing the electronic data file (page 3, number 1: Here, opening the document in the original format is retrieving a stored document).

As per dependent claim 23 ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam discloses routing the converted data file to a supervisor and a subsequent document designate (column 2, lines 37-40).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Alam's medium for publication with

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Alam's method for transmitting the document, since it would have allowed a user to submit data to another.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS, Bendik, and Alam and further in view of Ouchi (U.S. 6,370,567, filed 3 October 1999, patent 9 April 2002).

As per dependent claim 24 ATS, Bendik, and Alam disclose limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS, Bendik, and Alam fail to specifically disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the medium of ATS, Bendik, and Alam with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.



Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Bendik and further in view of Chen et al. (U.S. 6,009,442, hereafter Chen, filed 8 November 1997, patent 28 December 1999).

As per dependent claim 26 ATS and Bendik disclose the limitations similar to those in claim 25 and the same rejection is incorporated herein. ATS fails to disclose a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document. However, Chen discloses a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document (column 4, lines 9-11; column 4, lines 22-27).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the ATS and Bendik's system with Chen's system of assigning a document identifier to a document upon document generation, since it would have allowed a user to save a document with a default set of document attributes that are set upon document creation.

Claim 28 remains rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Bendik in view of Ouchi.

As per dependent claim 28 ATS and Bendik disclose limitations similar to those in claim 25, and the same rejection is incorporated herein. ATS fails to specifically disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12;

column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the system of ATS with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

#### **(10) Response to Argument**

With respect to claim 1, the appellant argues that there is no motivation to combine the teachings of ATS with Bendik (pages 7-9). This appears to stem from the appellant's assertion that Bendik neither teaches nor suggests converting a document from its original format to any other format (page 8). However, Bendik is not relied upon to teach converting a document from its original format to any other format. Bendik is merely relied upon to teach a document management system (DMS) (FOA: page 3). Further, the appellant acknowledges that Bendik teaches a DMS and how it is used (page 8). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, ATS discloses converting a data file into a publication (page 5). However, ATS fails to teach a DMS. Bendik teaches a DMS (paragraphs 0007-0013). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS publication with Bendik's DMS, since it would have allowed a user to use the advantages of a DMS, namely, easily sharing documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0003).

Further, the applicant argues that ATS fails to provide a choice of publication format, instead requiring conversion to a PDF (page 10). While this may be accurate, the appellant's claim limitation require, "selecting a publication format via the publication enabler (claim 1, line 10)." Further, the appellant claims "initializing a publication enabler capable of converting the data file into at least one publication format in response to the publication instruction (claim 1, lines 6-7)." This limitation requires that at least one publication format be presented. PDF is the at least one publication format. By allowing conversion to a PDF, the limitation of selecting a publication format via a publication enabler, which is only required to be capable of converting a data file into at least one publication format in response to a publication instruction is met.

Further, the applicant reiterates the belief that ATS fails to provide a document management system (pages 10-11). As the examiner has previously stated, Bendik is relied upon to teach this limitation, and motivation for combining the references has

been provided above.

With respect to claim 5, the appellant argues that ATS fails to disclose transmitting the data file and document parameters to the DMS (pages 11-12). The examiner respectfully disagrees. ATS discloses the method wherein the step of publishing further comprises the step of transmitting the data file to a system wherein the data file are configured to allow the system to automatically assign a coded filename, a storage location, and a file identifier to the data file (page 5, number 7: Here, the file is saved to the hard drive in a document management system under a filename). The examiner acknowledges that ATS does not disclose providing the parameters to the DMS, however, Bendik further discloses the method wherein a document management system receives a plurality of parameters used to automatically assign a file a coded filename, a storage location, and a file identifier (paragraph 0049: Here, a naming system is created when the document management system is implemented. This naming system specifies the coded file name, storage location, and file identifier that all documents will receive, based upon the document's parameters).

With respect to claim 8, the appellant presents arguments similar to those presented with respect to claim 1.

With respect to claim 25, the appellant presents arguments similar to those presented with respect to claim 1.

With respect to claims 12 and 16, the applicant argues that there is no motivation to combine ATS with Bendik, and further ATS and Bendik with Alam (pages 15-17). The examiner has already addressed the motivation to combine ATS and Bendik (see

argument with respect to claim 1). Further, Alam discloses receipt of one publication command generating electronic media in a plurality of formats (Figure 6, items 626 and 534). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik with Alam, since it would have allowed a user to generate multiple documents for several applications. The appellant argues that no basis has been provided for this assertion (page 16). However, Alam discloses generation of two documents, in different formats based upon one publication command (Figure 6, items 626 and 534: Here, one format is a PDF and a second format is an Output Format Document. Each of these documents are used for different applications).

Further, the applicant argues that the combination of ATS, Bendik, and Alam fail to teach all the limitations of the claim, specifically, conversion of an electronic data file into at least two of a number of publication formats (pages 17-18). However, both ATS and Alam teach conversion of an electronic data file into a PDF, a publication format (ATS: page 5; Alam: Figure 6). Although ATS fails to teach two of a number of publication formats, Alam discloses conversion of an electronic data file into a plurality of formats (Figure 6). As the examiner has already stated, It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik with Alam, since it would have allowed a user to generate multiple documents for several applications.

With respect to claim 24, the appellant argues that there is no motivation to combine the references (pages 18-19). The examiner respectfully disagrees. Although

Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the medium of ATS, Bendik, and Alam with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

Further, the applicant argues that Ouchi fails to disclose a list of supervisors (pages 19-20). The examiner acknowledges this. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

With respect to claim 26, the appellant argues that there is no motivation to combine the references (pages 20-21). The examiner respectfully disagrees. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the ATS and Bendik's system with Chen's system of assigning a document identifier to a document upon document generation, since it would have allowed a user to save a document with a default set of document attributes that are set upon document creation.

Further, the appellant argues that Chen fails to disclose automatic generation of a file name (page 21). Chen creates a new STG file for each new document (column 4, lines 9-11). Further, the STG file contains a data field including a file name (column 4, lines 22-27).

With respect to claim 28, the appellant presents arguments similar to those presented with respect to claim 24.

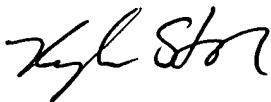
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

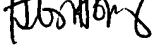
Respectfully submitted,

Kyle R. Stork



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER

Conferees:

Stephen Hong   
Supervisory Patent Examiner 2178  
Heather Herndon  
Supervisory Patent Examiner 2176

  
Heather R. Herndon  
Supervisory Patent Examiner  
Technology Center 2100

Ziolkowski Patent Solutions Group, SC  
14135 North Cedarburg Rd.  
Mequon, WI 53097-1416